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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,106	06/01/2001	Ellis L. Reinherz	1062.1021-004	2390

21005 7590 05/09/2005

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EXAMINER

VANDERVEGT, FRANCOIS P

ART UNIT PAPER NUMBER

1644

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/873,106	REINHERZ ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	F. Pierre VanderVegt	1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9, 11, 13-15, 17-19, 21-44, 46-58 and 62-64 is/are pending in the application.
- 4a) Of the above claim(s) 1-6, 23-43 and 47-53 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7, 9, 13, 14, 17, 18, 21, 22, 44, 46, 54 and 62-64 is/are allowed.
- 6) ☐ Claim(s) 11, 15, 19 and 55-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

*Handwritten mark*

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### DETAILED ACTION

This application claims the benefit of the filing date of provisional application 60/148,815.

New claims 62-64 have been added.

Claims 8, 10, 12, 16, 20, 45 and 59-61 have been canceled.

Claims 1-7, 9, 11, 13-15, 17-19, 21-44, 46-58 and 62-64 are currently pending.

Claims 1-6, 23-43 and 47-53 stand as withdrawn. Applicant is reminded of the requirement under 37 CFR 1.121(c) to recite the full text of all withdrawn claims in the complete listing of the claims.

Claims 7, 9, 11, 13-15, 17-19, 21, 22, 44, 46, 54-58 and 62-64 are the subject of examination in the present Office Action.

1. In view of Applicant's amendment and remarks filed December 9, 2004, no outstanding grounds of rejection have been maintained.
2. The following new grounds of rejection necessitate that this Office Action be made NON-FINAL.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 11, 15 and 19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 11 recites an isolated nucleic acid molecule "comprising" a nucleic acid molecule that encodes SEQ ID NO: 3 or the complement of said nucleic acid molecule. The term "comprising" is an open term that is understood to mean a polypeptide containing the recited sequence with any other combination of amino acid residues attached thereto.

The instant specification discloses only a single protein comprising the fragment disclosed as SEQ ID NO: 3, that single protein being the CD2BP2 protein of SEQ ID NO: 2

Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession

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*of the invention.* The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed.*

Accordingly, the instant specification provides written descriptive support for nucleic acid molecules encoding a polypeptide consisting of SEQ ID NO: 3 or consisting of a fragment of SEQ ID NO: 2 comprising SEQ ID NO: 3, or the complement thereof.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 55-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 55 and 58 are ambiguous and unclear in the recitation of "a fragment of human protein of SEQ ID NO: 2 that comprises a polypeptide of SEQ ID NO: 3." It is not clear whether the claimed nucleic acid molecule must encode the entire sequence of SEQ ID NO: 3 or only a portion of it. It is suggested that the claim be amended to recite --a fragment of human protein of SEQ ID NO: 2 that comprises the polypeptide of SEQ ID NO: 3--.

### *Conclusion*

7. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

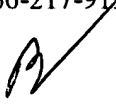
8. Claims 7, 9, 13, 14, 17, 18, 21, 22, 44, 46, 54 and 62-64 are allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Pierre VanderVegt whose telephone number is (571) 272-0852. The examiner can normally be reached on M-Th 6:30-4:00 and Alternate Fridays 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

F. Pierre VanderVegt, Ph.D. 

Patent Examiner

April 28, 2005



DAVID SAUNDERS

PRIMARY EXAMINER

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